

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

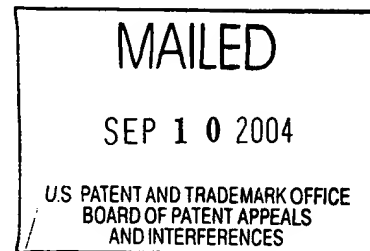
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES W. ROSE and THEODORE C. CHEN

Appeal No. 2004-0330
Application 09/302,034

ON BRIEF



Before KRASS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 37-126.

The invention relates to an Internet based computer reservation system. In particular, it pertains to an on-line reservation system for restaurants, illustrated, for example, by reference to representative independent claim 99, reproduced as follows:

99. A method comprising:

providing a first restaurant a first reservation booking database having a plurality of records, the plurality of records corresponding to a plurality of time-slots for tables at the first restaurant

providing a restaurant table reservation management module configured to enable the first restaurant to book time-slots in the first reservation booking database to reserve the tables at the first restaurant for customers not making bookings over the Internet; and

providing an Internet booking module configured to enable an Internet user to book an available one of the time-slots to reserve one of the tables at the first restaurant.

The examiner relies on the following references:

Steadham Jr. et al (Steadham)	5,634,016	May 27, 1997
Fukuma	5,909,668	Jun. 1, 1999
		(filed Aug. 28, 1996)
Henneuse et al. (Henneuse)	5,963,913	Oct. 5, 1999
		(filed Feb. 28, 1997)
Cummings, Jr. et al. (Cummings)	6,345,260	Feb. 5, 2002
		(filed Mar. 16, 1998)
Cotton et al. (Cotton)	WO00663808	Oct. 26, 2000
		(eff. filing date Apr. 16, 1999)

King, Julia "Agents of Change: Technology Firm Poised to Shake Up Hotel Reservations Systems" Computerworld, (Dec. 26, 1995)v3.0 n 1 pp32 et seq. (King)

Datalex, "Bookit Is the Internet Booking Engine of Choice for On-Line Travel Reservations", (March 12, 1999) (Datalex)

Hilton Press Releases "Hilton to Develop New Centralized Reservations System" (Oct. 27, 1997) (Hilton)

PR Newswire "Extensity Partners with Internet Travel Network" (Aug. 3, 1998) (Extensity)

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Business Wire "Marriott Villas Turn to Internet to Offer
Travelers One-Stop Shopping" (Oct. 1, 1998) P1262 et seq.
(Marriott)

Booker, Ellis "Choice Hotels opens its doors on the Internet"
Computerworld; Framingham; (Jul. 3, 1995) (Booker)

Claims 37-126 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Fukuma, Henneuse, Cummings, Booker, Cotton, King, Hilton, Marriott, Extensity and Datalex with regard to claims 37-81 and 85-126, adding Steadham to the original combination with regard to claims 82-84, 101 and 103.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth

in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

Each of the independent claims requires, in one form or another, a reservation booking database for a plurality of time-slots for tables at a restaurant wherein users of the Internet may book an available time-slot in the reservation booking database and a restaurant maintenance module having a management module is also provided for enabling the restaurant to book time-slots in the reservation booking database to reserve tables at the restaurant for customers not making bookings over the Internet. Thus, there must be both a web site module, enabling reservations over the Internet and a restaurant maintenance module enabling the restaurant access to the reservation booking database in order to reserve tables for customers not making bookings over the Internet.

The examiner has found it necessary to apply no less than ten references for this concept of providing two modules, one for access to a database via the Internet, and one for access to the database for those not using the Internet. While there is no limit, theoretically, to the number of references which may be combined in order to find claimed subject matter obvious under 35 U.S.C. § 103, the examiner's rationale provides no suggestion in any one of them, or in any combination of them, for this concept of two modules providing for access to a database either via the Internet or otherwise.

The primary reference to Fukuma relates to a reservation system but it pertains to dividing up a banquet hall into different partition patterns, making different table arrangements depending on information input by the banquet hall provider, but, in Fukuma, it appears that only the banquet hall provider inputs the reservation information and that information is not directed to time-slots for tables (other than for some elected date), as claimed, but, rather, to reserving some arbitrary area of the banquet hall. In any event, there does not appear to be a disclosure or a suggestion of the two modules required by the instant claims, especially a module permitting Internet access.

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The examiner recognizes that, at least, Fukuma has no disclosure of Internet access, so the examiner applies Marriott, Hilton, King, Datalex and Extensity to teach booking reservations over the Internet. The examiner applies Henneuse for a teaching of scheduling an event utilizing a network. The examiner applies Cummings for the teaching of a reservation booking database accessible by an Internet user for scheduling time-slots, or appointments. The examiner applies Cotton for a teaching of a multi-tiered reservation system for restaurants over the Internet.

From these alleged teachings, the examiner finds that it would have been obvious "to combine Fukuma in view of Henneuse to teach part of the above" (answer-page 5) because of a motivation the examiner identifies as "to teach a computerized system for scheduling an event utilizing a server application that assures accurate availability information is present to schedule the event as enunciated by Henneuse (col 1 line 37-col 2 line 23)" (answer-page 5). However, the examiner never identifies what "part of the above" is being referenced and to exactly what portions of the claimed subject matter the examiner is applying Fukuma and Henneuse.

The examiner's cryptic "part of the above" does not indicate exactly what portion of the claimed subject matter is being referenced by the examiner. Moreover, the remainder of the examiner's reasoning appears to be no more than double-talk babble, indicating no specifics as to why, exactly, the skilled artisan would have been led to make the alleged combination. The portion of Henneuse cited by the examiner is a description of Henneuse's summary of Henneuse's invention and is a very general description of scheduling an event subject to the availability of requested participants. It is not clear what, exactly, in this description would have led the artisan to make some modification to the Fukuma system of rearranging banquet halls.

The examiner further contends that it would have been obvious to combine Cummings with Fukuma and Henneuse, the motivation being "to teach an asynchronous Internet compatible 24 hour appointment (event) scheduling interface for an Internet client user as enunciated by Cummings (col 2 lines 1-29)" (answer-page 5), as well as to add the teaching of Booker, the motivation being "to teach a hotel reservation system accessible by Internet users as taught by Booker" (answer-page 5). Finally, the examiner adds King, Hilton, Marriott, Extensity, Datalex and

Cotton "to teach all of the applicant's claim" (answer-page 5), the motivation being "to teach the use of an Internet reservation system with time-slots to enable an Internet user to book a using WEB-based bookings reservations in a restaurant as much as 24 hours a day as enunciated by Cotton (page 1 line 25-page 2 line 22).

Again, with all due respect to the examiner, we find this rationale to be nothing more than babble, making absolutely no sense to us. The examiner has provided no specifics as to why the skilled artisan would have been led, by some specific teachings of the secondary references, to make specific modifications to the system of rearranging banquet halls in the primary reference. The examiner throws King, Hilton, Marriott, Extensity and Datalex into the mix "to teach all of the applicant's claim" but never indicates what it is, in these references, on which the examiner relies, nor to what portions of the claims the references are being applied. These references appear to be nothing more than very general teachings of booking reservations over the Internet, with very little as to the specifics of the systems.

More importantly, even assuming, arguendo, that everything alleged by the examiner is true, the examiner's rationale does not appear to touch on the fact that the instant claims require both a web site module, enabling reservations over the Internet and a restaurant maintenance module enabling the restaurant access to the reservation booking database in order to reserve tables for customers not making bookings over the Internet.

Taken at its best, we can only construe the examiner's rationale to find that, in view of all of these references, it would have been obvious to book reservations using the Internet. If this is all the examiner was trying to convey, we agree that it would have been obvious to book reservations over the Internet in view of the applied references. But the instant claims require more than mere reservation bookings over the Internet. In addition to a web-site permitting such Internet reservation bookings, the claims also require a restaurant maintenance module enabling the restaurant access to the reservation booking database in order to reserve tables for customers not making bookings over the Internet.

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The examiner does not appear to come to grips with this additional required claim limitation. Perhaps, by contending that Fukuma teaches the claimed subject matter but for an Internet connection, the examiner was attempting to use Fukuma for a teaching of the claimed table reservation management module for booking time-slots in the reservation database to reserve tables for customers not making bookings over the Internet, and then employ general teachings of Internet reservation bookings to show that both Internet and non-Internet bookings were known. The problem is that it is unclear as to what, exactly, the examiner is attempting to show, what the examiner is attempting to combine, or for what purpose. The examiner's rationale appears to provide very little, if any, support for allegations of combinability of the references. In short, we find no prima facie case of obviousness established by the examiner in accordance with 35 U.S.C. § 103. Accordingly, we will not sustain the rejection of claims 37-81 and 85-126 under 35 U.S.C. § 103.

Further, since the reference to Steadham does not appear to provide for the deficiencies of the other applied references, we also will not sustain the rejection of claims 82-84, 101 and 103 under 35 U.S.C. §103.

It may be that the examiner is attempting to point out that the reservation bookings in Fukuma are made by the restaurant (or banquet hall) without the use of the Internet, while the other references indicate that it was also known to make reservation bookings via the Internet and so the examiner combines the two teachings to conclude that it would have been obvious to make reservation bookings using both Internet and non-Internet options.

If this is, indeed, what the examiner is trying to convey, the rationale still does not address the question as to why the skilled artisan would have found it obvious to modify Fukuma to provide for an Internet option. There would have been no reason to employ an Internet option in Fukuma because it would make no sense to permit customers using the Internet to determine the partition pattern of the banquet hall based on reservations because no one customer would have access to other customers'

needs and it would be ludicrous for each individual customer to have the ability to change the layout of the banquet hall without knowing the needs of other customers. Only the banquet hall (or restaurant, if you will) management can have access to the required information to make the required changes to the partitioning. Thus, we find no convincing rationale for modifying Fukuma in such a manner to result in the instant claimed subject matter.

If there is some suggestion, within the applied references, to use both a web site module, enabling reservations over the Internet and a restaurant maintenance module enabling the restaurant access to the reservation booking database in order to reserve tables for customers not making bookings over the Internet, the examiner certainly has not identified that reference or portion thereof. And, while it might, in fact, have been obvious to provide for both Internet reservations and access to a reservations database without using the Internet, the examiner has clearly not provided any convincing rationale for doing so. It would appear that if making restaurant reservations via the Internet is known, then an argument could be made about the obviousness of providing for walk-in or telephone

reservations in addition to the Internet reservations since the artisan would have understood that, for practical reasons, a restaurant would not rely solely on the Internet for its business. Accordingly, a restaurant is not about to turn away a customer using a telephone, or walking into the restaurant seeking a table. Yet, the restaurant cannot give the telephone/walk-in customer a table already reserved over the Internet, so it would have appeared to have been obvious that the restaurant personnel would have some means of accessing its reservation database to avoid conflicts. Therefore, with the correct rationale and the proper references, it would appear that one could establish a case of obviousness of the instant claimed subject matter. However, in the instant case, the examiner has not done so. It may even be that some or all of the cited references may be properly combinable to form a prima facie case of obviousness with regard to the instant claimed subject matter, but, again, the examiner simply has not made that prima facie case with the rationale proffered.

"Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d

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1693, 1697 (Fed. Cir. 2001). Furthermore, "the Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Since the examiner has not provided us with anything more than general conclusions about the obviousness of the instant claimed subject matter, with no clear documentation as to how such a conclusion of obviousness may be reached from the evidence provided by the applied references, we cannot sustain the rejections of the claims under 35 U.S.C. § 103.

Because the examiner has not even set forth what may be considered a prima facie case of obviousness, we need not reach the appellants' arguments since the examiner has the initial burden of establishing the case for unpatentability.

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Since we cannot sustain the rejections based on the case provided by the examiner's rationale, the examiner's decision rejecting claims 37-126 under 35 U.S.C. §103 is reversed.

REVERSED



ERROL A. KRASS)
Administrative Patent Judge)




JERRY SMITH)
Administrative Patent Judge)

) BOARD OF PATENT

) APPEALS AND

) INTERFERENCES



MICHAEL R. FLEMING)
Administrative Patent Judge)

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